UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PAUL TURGEON

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Appeal 2010-002919
Application 10/086,793
Technology Center 3600

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges.*

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Paul Turgeon (Appellant) seeks our review under 35 U.S.C. § 134
(2002) of the final rejection of claims 1-15, 40-54, 61-69, and 77-90. We
have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.[1]

THE INVENTION

The invention relates to "performing secure, authenticated real-time financial transactions over a public access network." Specification 1:13-14.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of providing a payment service including the steps of:

   processing a payment service request having independent identification information and a pair of ATM network compatible PINs, including the steps of:

   validating said independent identification information; and

   generating an ATM network transaction message containing at least a selected one of said pair of ATM network compatible PINs based at least in part on said validating step; and

   forwarding said ATM network transaction message to a financial institution over an ATM network for payment.

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[1] Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed Mar. 27, 2006) and Reply Brief ("Reply Br.," filed Aug. 29, 2006), and the Examiner's Answer ("Answer," mailed Jul. 13, 2006).

THE REJECTION

The Examiner relies upon the following as evidence of

unpatentability:

| Levine | US RE38,255 E | Sep. 23, 2003 |
| Martin, Jr. | US 2004/0199467 A1 | Oct. 7, 2004 |

IBM Research Disclosure RD414097, "Dual pin modes for secure access for banking systems," published Oct. 1998. [IBM]

The following rejection is before us for review:

1. Claims 1-15, 40-54, 61-69, and 77-90 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin, Jr., Levine, and IBM.

ISSUE

The central issue is whether it would have been obvious to one of ordinary skill in the art given the cited prior to "process[ ] a payment service request having ... a pair of ATM network compatible PINs" (claim 1)?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

Claims 1-15

The Appellant argued claims 1-15 as a group (App. Br. 9-10). We

select claim 1 as the representative claim for this group, and the remaining claims 2-15 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii)(2007).

The Examiner's position is that Martin, Jr. discloses all the claimed limitations but for the pair of ATM network compatible PINs, for which Levine and IBM are relied upon. Answer 3-4.

The Appellant argues that "nothing in any of the cited references teaches the inclusion of a pair of PINs in a payment service request, the description in all of the references always being limited to the use of a single PIN in a service request." App. Br. 10.

Accordingly, there is no dispute that the cited prior art discloses processing a payment service request with a single ATM network compatible PIN. The difference between the claimed invention and that of the prior art is that the claimed method processes a payment service request with a *pair* of ATM network compatible PINs.

Levine and IBM disclose using a *pair* of ATM network compatible PINs, although it appears that only one of the pair of ATM network compatible PINs is disclosed as being used when a payment service request is processed. *See, e.g.*, Levine (col. 7, ll. 40-44: "The service agent first inputs ... the desired new PIN number ... The old PIN could also be required ... .") *See also* IBM (p. 1: "The method involves allocating a first and second PINs to a user of a credit card, or ATM card.")

The issue is whether it would have been obvious to one of ordinary skill in the art given the cited art combination to process a payment service

request with a *pair* of ATM network compatible PINs.

We have carefully considered the record. We find that the evidence weighs more in favor of the Examiner's position.

It is important to point out that the claim does not require *both* of ATM network compatible PINs for acceptance of the payment service request. When reasonably broadly construed, the claim recites no function for the pair of PINs as claimed except to be "include[d]" in the payment service request during processing and "contain[ed]" in a generated transaction message. Accordingly, the claimed method covers the combination of the prior art method of processing a payment service request via a single ATM network compatible PIN with a (nonfunctional) second ATM network compatible PIN. In that regard, given Levine and IBM, it would have been obvious to one of ordinary skill in the art to include another ATM network compatible PIN in the payment service request. It would have been obvious, for example, to duplicate the single ATM network compatible, or, as Levine suggests, to include an old PIN with the new one, and thereby include a second ATM network compatible PIN as part of the payment service request.

Furthermore, one would reach the claimed method by simply combining Martin, Jr. payment service request with Levine's or IBM's pair of ATM network compatible PINs. There is no evidence that such a combination produces anything that one of ordinary skill in the art would not expect; that is, a payment service request with pair of ATM network

compatible PINs. *Cf. KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("[W]hen a patent "simply arranges old elements with each performing the same function it had been known to perform" and yields no more than one would expect from such an arrangement, the combination is obvious.")

We disagree with the Appellant that Levine and IBM teach away from including two PINs in a service request. App. Br. 10. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant." *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001). Nothing in these references would lead one away from including a second PIN as broadly claimed.

For the foregoing reasons, we are not persuaded as to error in the prima facie case of obviousness for the subject matter of claim 1 over the cited prior art combination. Because claim 2-5 stand or fall with claim 1, we reach the same conclusion for the prima facie case of obviousness for the subject matter of these claims.

Claims 40-54

The Appellant argued claims 40-54 as a group (App. Br. 10). We select claim 40 as the representative claim for this group, and the remaining claims 41-54 stand or fall with claim 40. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellant argued against the rejection of claim 40 for the same

reasons used to argue against the rejection of claim 1. App. Br. 10.
Accordingly, because we found them unpersuasive as to that rejection, we
find them equally unpersuasive as to error in the rejection of claim 40. Since
claims 41-54 stand or fall with claim 40, their rejection is also sustained.

Claims 61-69

The Appellant argued claims 61-69 as a group (App. Br. 10-11). We
select claim 61 as the representative claim for this group, and the remaining
claims 62-69 stand or fall with claim 61. 37 C.F.R. § 41.37(c)(1)(vii)
(2007).

The Appellant argues that the "art fails to disclose "providing an
encoded data storage device to a user" that includes both "data representing
a first ATM network compatible PIN [that is] a valid ATM PIN associated
with said user's account at a financial institution" and "data representing a
second ATM network compatible PIN [that is] an invalid ATM PIN not
associated with said user's account at said financial institution." App. Br. 10
(quoting claim 61).

The Examiner had relied on Levine and IBM as showing a data
storage device. Answer 5.

We have reviewed the record and find that it weighs in favor of the
Examiner's position.

The Appellant argues that the encoded data storage device includes
data representing a valid PIN and an invalid PIN, which information

Appellant argues the prior art does not disclose. However, Levine in particular discloses ATM cards (see col. 1), which are devices with stored data issued to a user.

As is well known, ATM cards include data representing a number of different pieces of information. Accordingly, the difference between the device claimed and an ATM card as Levine discloses lies in the information their stored data represent. Such a difference is a matter of nonfunctional descriptive material and as such is not patentably consequential. The difference between data representing PINs as stored in Appellant's device and data representing other types information stored on an ATM card is a difference in data's informational content. That informational content of the data which is characterized as PINs is properly considered to be nonfunctional and descriptive.

The Appellant has not come forward with evidence sufficient to show that the structure of the data is functionally affected by it being, specifically, a valid PIN and an invalid PIN. Absent such evidence, it is reasonable to conclude that the PIN aspect of the stored data is descriptive and not functionally related to any structure of the claimed invention and as such falls under the category of patentably inconsequential subject matter. *See Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) ("Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded

on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.) *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative).

For the foregoing reasons, we will sustain the rejection of claim 61. Since claims 62-69 stand or fall with claim 61, their rejection is also sustained.

Claims 77-90

The Appellant argued claims 77-90 as a group (App. Br. 77-90). We select claim 77 as the representative claim for this group, and the remaining claims 78-90 stand or fall with claim 77. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellant argued against the rejection of claim 77 for the same reasons used to argue against the rejection of claim 40. App. Br. 10.

Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claim 77. Since claims 78-90 stand or fall with claim 77, their rejection is also sustained.

DECISION

The decision of the Examiner to reject claims 1-15, 40-54, 61-69, and 77-90 is affirmed.

AFFIRMED

JRG